REMARKS

Claims 1-29 were examined and reported in the Office Action. Claims 1-29 are rejected. Claims 1, 9, 17, 21 and 25 are amended. Claims 1-29 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I.   35 U.S.C. §103(a)

It is asserted in the Office Action that claims 1-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,872,588 issued to Aras et al ("Aras"), in view of U.S. Patent Pub. 2002/0059610 A1 by Ellis ("Ellis"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

> [t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's amended claim 1 contains the limitations of "a VOD content decoder coupled to the first processor; a video and audio formatting processor coupled to the

first processor and the content decoder; and an index memory coupled to the first processor, wherein the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one user selectable recording of the at least one partial VOD program content where the at least one partial VOD program content has already been viewed, and <u>each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment.</u>

Applicant's amended claim 9 contains the limitations of "<u>a video-on-demand (VOD) service provider coupled to a plurality of set-top-box (STB) units</u>, wherein each of the plurality of STB units comprises a first processor coupled to a communications channel device, the communications device capable of receiving and transmitting information to a VOD service provider; a VOD content decoder coupled to the first processor; a video and audio formatting processor coupled to the first processor and the content decoder; and an index memory coupled to the first processor, wherein the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one user selectable recording of the at least one partial VOD program content where the at least one partial VOD program content has already been viewed, and each of the plurality of STB units are capable of communicating with each other, and <u>each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment.</u>

Applicant's amended claim 17 contains the limitations of "<u>ordering at least one video-on-demand (VOD) program from a VOD service provider from a first set-top-box (STB) unit</u>; playing at least one VOD program; selecting a start and stop time for recording <u>a representation</u> of <u>a segment</u> of the at least one VOD program, wherein the start and stop time are user selectable; converting a VOD program identifier of the at least one VOD program to a text representation; one of converting the text

representation of the VOD program identifier of the at least one VOD program into a unique encoded digital representation and receiving a unique encoded digital representation from the VOD service provider; converting the start and stop time for a segment of the at least one VOD program to a digital representation; and <u>storing the VOD program identifier encoded digital representation and the start and stop digital representation as a single identifier in an index memory.</u>"

Applicant's amended claim 21 contains the limitations of "order at least one video-on-demand (VOD) program from a VOD service provider from a first set-top-box (STB) unit; convert a VOD program identifier of the at least one VOD program to a text representation; one of convert the text representation of the VOD program identifier of the at least one VOD program into a unique encoded digital representation and receive a unique encoded digital representation from the VOD service provider; convert a start and stop time for at least one segment of the at least one VOD program to a digital representation, where the start and stop time for the at least one segment of the at least one VOD program are user selectable and are based on a stop and a start time of a recorded representation of the at least one segment of the at least one VOD program where the at least one segment of the at least one VOD program has already been viewed; and <u>store the VOD program identifier encoded digital representation and the start and stop digital representation as a single identifier in an index memory.</u>"

Applicant's amended claim 25 contains the limitations of "a first processor coupled to a communications channel device, the communications device capable of receiving and transmitting information to a video-on-demand (VOD) service provider; a VOD content decoder coupled to the first processor; a video and audio formatting processor coupled to the first processor and the content decoder; and an index memory coupled to the first processor, wherein the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one recording of the at least one partial VOD program content where the at least one partial VOD program content has already been viewed, and a user can send at least one VOD program segment representation of the plurality of VOD program segment representations of at least one partial VOD program as an electronic mail (email) attachment to another communications device located at a different venue, and each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment.

Aras discloses a method and apparatus for content coding audio-visual materials where the coding is used to determine subscribers selection. All audio-visual content is encoded with a unique identifier that is encoded at specific intervals. When content is viewed by a subscriber, the encoded identifiers are recorded. The provider can then determine, based on the identifiers, what program or sub-portion of a program the subscriber has viewed. That is, based on a minimum of two identifiers, the invention disclosed in Aras can determine when a viewer started to watch a program and when the user stopped watching the program. Aras does not disclose that a user can select a start time and a stop time of a segment of a program that is stored as a single unique identifier along with the program, the date of the program. Applicant's claimed invention stores the unique identifier and can transmit the identifier to another user via email. The user can then view the selected segment without having to have the segment, itself, sent in the email.

Thus, Aras does not teach, disclose or suggest the limitations contains in: claim 1 of "each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment," in claim 9 of "each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment," in claim 17 of "storing the VOD program identifier encoded digital representation and the start and stop digital representation as a single identifier in an index memory," in claim 21 of "store the VOD program identifier encoded digital representation and the start and stop digital representation as a single identifier in an index memory," and in claim 25 of "a user can send at least one VOD program segment representation of the plurality of VOD program segment representations of at least one partial VOD program as an electronic mail (email) attachment to another communications device located at a different venue, and each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment."

Ellis discloses a method of adding programs to a watch-list. The watch-list is a reminder to a person that they wanted to watch a certain program at a certain time. Ellis also discloses that the program can be stored, completely, in a file format or recorded to a medium, such as a videocassette or writeable disk. In Applicant's claimed invention, however, a user can select a start and stop time of a segment of a program that the user would like another person to see. The stop and start times are stored along with the program identification and date in a single identifier. The single identifier does not include, at all, any copies or images of the program. Instead, the identifier only identifies the program name, date, and start and stop time the user wants another to be able to see. This identifier is emailed as an attachment to another user. Ellis simply does not teach, disclose or suggest the limitations contains in: claim 1 of "each of

said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment," in claim 9 of "each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment," in claim 17 of "storing the VOD program identifier encoded digital representation and the start and stop digital representation as a single identifier in an index memory," in claim 21 of "store the VOD program identifier encoded digital representation and the start and stop digital representation as a single identifier in an index memory," and in claim 25 of "a user can send at least one VOD program segment representation of the plurality of VOD program segment representations of at least one partial VOD program as an electronic mail (email) attachment to another communications device located at a different venue, and each of said plurality of VOD program segment representations is an identifier identifying a VOD program, a date the VOD program originally aired, a start time of a user selectable recording of a VOD program segment and a stop time of the user selectable recording of the VOD program segment."

Therefore, even if Aras were combined with Ellis, the resulting invention would still not include all of Applicant's claimed limitations. And, therefore, there would be no motivation to combine Aras with Ellis. Moreover, by viewing the disclosures of Aras and Ellis, one can not jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2142,

> [t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the 'subject matter as a whole' of the invention. The

> tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to storing a single identifier that identifies a program, original program date, and start and stop time of a user selectable segment of the program, where a user can email the identifier to another so that the other user can view the segment based on the identifier.

Neither Aras, Ellis, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's amended claims 1, 9, 17, 21 and 25, as listed above. Since neither Aras, Ellis, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 9, 17, 21 and 25, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's amended claims 1, 9, 17, 21 and 25 are not obvious over Aras in view of Ellis since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1, 9, 17, 21 and 25, namely claims 2-8, 10-16, 18-20, 22-24, and 26-29, respectively, would also not be obvious over Aras in view of Ellis for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection for claims 1-29 is respectfully requested.
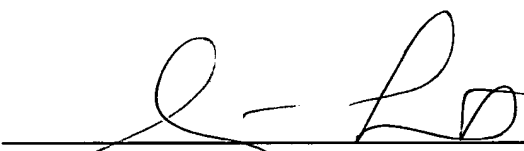
CONCLUSION

In view of the foregoing, it is submitted that claims 1-29 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

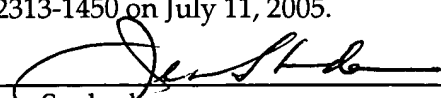BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: July 11, 2005   By: _____

Steven Laut, Reg. No. 47,736

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on July 11, 2005.

Jean Svoboda